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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BECKER et al. Docket No.: 375551-001C2
Serial No.: 10/785,497 Group Art Unit: 1654
Filed: February 24, 2004 Examiner: Leary, Louise N.
For: PRODRUGS OF PHOSPHONATE NUCLEOTIDE ANALOGUES AND METHODS FOR
SELECTING AND MAKING SAME

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS

Sir:

In response to the Notice to File Corrected Application Papers mailed February 10, 2005 in the captioned application, Applicant's submit the following papers, which are discussed in the Remarks section of this paper:

1. A copy of the Notice (Exhibit 1);
2. A copy of a Preliminary Amendment filed July 17, 2004 in the captioned application (Exhibit 2);
3. A copy of an Information Disclosure Statement filed July 17, 2004 in the captioned application (Exhibit 3);
4. A clean Substitute Specification (Exhibit 4);
5. A marked-up Substitute Specification (Exhibit 5); and
6. A copy of a Revocation and Power of Attorney being submitted concurrently (Exhibit 6).

On May 17, 2004, the Patent Office mailed a Notice to File Corrected Application Papers in the instant application ("first Notice") that is identical to the Notice mailed February 10, 2005 ("second Notice"). In response to the first Notice, on July 17, 2004, Applicants' submitted a Preliminary Amendment, an Information Disclosure Statement ("IDS") and clean and marked-up copies of the Substitute Specification requested in the first Notice. Since these papers were filed prior to the first Notice being withdrawn, in response to the second Notice, Applicants submit herewith a copy of their Preliminary Amendment of July 17, 2004 (Exhibit 2) and the IDS referenced therein (Exhibit 3). Applicants request that this Preliminary Amendment be entered and the remarks therein and the IDS be considered by the Patent Office.

Also attached hereto are clean (Exhibit 4) and marked-up (Exhibit 5) versions of the Substitute Specification in accordance with 37 CFR §§ 1.52, 1.121(b)(3) and 1.125. However, it should be noted that these clean and marked-up versions of a Substitute Specification are not copies of the papers filed with the Preliminary Amendment of July 17, 2004. Since the filing of those papers, additional typographical errors were noted in the specification that required correction. These additional errors have been corrected in the Substitute Specification attached hereto. Accordingly, Applicants request that the specification of the instant application be replaced by the Substitute Specification attached hereto.

The majority of the changes made in the Substitute Specification are discussed in the July 17, 2004 Preliminary Amendment. In addition, the following changes have been made:

At page one of the original specification, immediately after the Title of the application, a cross-reference has been added identifying the applications to which benefit is claimed under 35 USC §§ 120 and 119(e). The amendment is supported by the Application Transmittal submitted with the application as filed.

At page 7, after the paragraph ending at line 25, a Brief Description of the Figures has been added. This description is supported by Figures 1, 2 and 3 embedded at pages 39, 48 and 49 of the original specification and the text associated therewith.

In the paragraph beginning at page 16, line 14 and ending at page 17, line 29, certain of the various substitute alternatives for variable R^{16} , R^{17} , R^{19} , R^{22} and R^{23} have been amended to illustrate explicitly obvious double and triple bonds.

In the paragraph beginning at page 20, line 25 and ending at page 21, line 28, the expression " $R^6=$ " has been amended to read " R^6 is."

In the definition of "alkyl" at page 22, lines 9-20, obvious extraneous parentheticals have been deleted from the exemplary alkyls $-CH_2CH_2CH_2CH_3$, $-C(CH_3)_2CH_2CH_2$ and $-CH_2CH_2CH(CH_3)_2$.

In Examples 1 and 2, headings have been added for clarity. In addition, throughout the application where structural diagrams are presented, the diagrams have been set-off with colons.

Lastly, the Abstract has been amended to focus with greater particularity on the presently claimed subject matter.

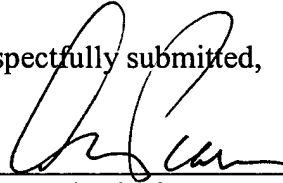
For the reasons discussed herein and in the Preliminary Amendment filed July 17, 2004, none of these amendments presents new matter. Accordingly, entry is proper.

All of the changes discussed herein and those discussed in the copy of the July 17, 2004 Preliminary Amendment attached hereto are highlighted in the enclosed marked-up copy of the Substitute Specification in accordance with 37 CFR § 1.125. However, because it appears as though the Substitute Specification submitted with the July 17 Preliminary Amendment has not yet been entered, the marked-up copy of the Substitute Specification enclosed herewith shows the changes made as compared to the original specification. Moreover, although the enclosed Substitute Specification includes paragraph and heading numberings that were not included in the original specification, because 37 CFR § 1.125 specifies that numberings of paragraphs are not considered changes that must be shown, these numberings are not highlighted in the marked-up copy of the Substitute Specification.

After entry of this Amendment, Claims 1-18 are pending and under consideration, and are believed to be in condition for allowance. An early indication thereof is therefore kindly solicited.

No fees beyond those included with the enclosed Petition to Extend Time under 35 USC § 1.136(c) are believed due. However, the Commissioner is authorized to charge any additional fees that may be required, or credit any overpayment, to Deposit Account No. 50-2778.

Respectfully submitted,



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Date: July 12, 2005

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/785,497	02/24/2004	Mark W. Becker	249.P1

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Foster City, CA 94404

CONFIRMATION NO. 9922

FORMALITIES LETTER



OC000000015157239

Date Mailed: 02/10/2005

NOTICE TO FILE CORRECTED APPLICATION PAPERS

Filing Date Granted


An application number and filing date have been accorded to this application. The application is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given TWO MONTHS from the date of this Notice within which to correct the informalities indicated below. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

The required item(s) identified below must be timely submitted to avoid abandonment:

- A substitute specification in compliance with 37 CFR 1.52, 1.121(b)(3), and 1.125, is required. The specification, claims, or abstract page(s) submitted is not acceptable and cannot be scanned or properly stored because:
 - The specification contains drawings or flow diagrams (37 CFR 1.58(a)) on page(s) figure 1 on page 39, figure 2 on page 48, and figure 3 on page 49. Drawings or flow diagrams cannot be embedded in the specification and should be submitted separately in accordance with 37 CFR 1.84. (Both a substitute specification and substitute drawings are required).

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*A copy of this notice **MUST** be returned with the reply.*


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